

enclose herewith a substitute declaration specifying that the inventors are "joint" inventors and giving their residence and mailing address information.

The Alleged Recapture

Claims 8-12 have been rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The Office Action states that the record of the application shows that the broadening aspect in the reissue relates to subject matter that Applicant previously surrendered during the prosecution of the application. This rejection and the reasoning underlying the rejection are respectfully traversed.

The Examiner has indicated that reissue claims 8 and 12 are directed to a system and method for estimating an input torque to be used in controlling an automatic transmission, while the original patented claims are directed to a system and method for controlling selection of gear position for an automatic transmission and include means and steps for estimating output torque.

That is precisely the point.

The instant claims 8-12 are concerned with input torque. The original patented claims include means and steps for estimating output torque. That is why there is no recapture and why the rejection is in error. The original application claims were not concerned with input torque. Limitations to input torque were not disclaimed in order to obtain allowance of the original claims. That was not even an issue. And that is why there cannot be recapture. One cannot recapture what one did not disclaim in the first place. Input torque and output torque are clearly two different quantities. The fact that Applicants did not originally present claims similar to the instant claims 8-12 is exactly the "error" (within the meaning of Section 251) that led to the filing of this reissue application.

The Office Action refers in particular to Reasons for Allowance in the original prosecution:

Claims 5...allowable because the combination of the means/step for estimating the output torque by one of two alternative methods are respectively recited in the claim, depending on whether the ratio between the input and output speeds of the torque converter is greater than a predetermined value, with the other limitations of the respective claims is deemed to have not been taught by the cited prior art.

That statement of the Reasons for Allowance certainly applies to claims 1-7. But claims equivalent to the instant claims 8-12 were not even present so they could not have been subjected to those Reasons for Allowance.

Paragraph B on page 3 of the Office Action states that the reissue claims attempt to claim the torque estimation system/method separately. Applicant respectfully submits that this is not so. The instant claims 8-12 are claiming a different torque estimation system. Claim 1-7 deal without output torque while the instant claims 8-12 deal with input torque. For that reason alone, the exact language of the patented claim need not be included in claims 8-12.

Considering the foregoing, it is respectfully submitted that the instant claims 8-12 are drawn to an aspect of the invention that was not claimed at any time in the parent application and was not relinquished in order to obtain allowance of other claims in the prosecution of the original application. It was (as noted previously) error not to have claimed that aspect of the invention. Accordingly, there is no recapture, and allowable claims 8-12 should again be allowed.

Since all the claims in this application are clearly in condition for allowance and distinguish over the prior art, an early Notice of Allowance is in order and the same is most earnestly solicited.

If there are any questions regarding this reply or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #381TO/41092RE).

Respectfully submitted,



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